

REMARKS/ARGUMENTS

Claims 1-3 and 12-14 stand rejected, with claims 4-11 and 15-24 objected to in the outstanding Official Action. Claims 12-24 have been cancelled without prejudice, claims 1, 4, 5, 7, 8, 10 and 11 amended and newly written claims 25-36 offered for consideration. Accordingly, claims 1-11 and 25-36 are the only claims remaining in this application.

The Examiner's acknowledgment of Applicants' claim for foreign priority and receipt of the certified copies of the priority documents is very much appreciated. Additionally, the Examiner's consideration of the prior art listed on Applicants' previously submitted Information Disclosure Statement is appreciated. Finally, the Examiner's indication of PTO acceptance of the previously submitted formal drawings is appreciated.

On page 2, section 1 of the Official Action, the Examiner objects to claims 4-11 and 15-24 as being in improper multiple dependent form. While the Examiner's assessment is believed to be correct with respect to former claims 5-11 and 15-24, there is believed no basis for objection to claim 4 in that it is entirely proper to have a singly dependent claim (claim 4) dependent from a proper multiple dependent claim, i.e., claim 3. Accordingly, any further objection to claim 4 is respectfully traversed. Applicants have amended remaining claims 5-11 to be singly dependent, thereby obviating any further objection.

Claims 1-3 and 12-14 stand rejected under 35 USC §102(e) as allegedly being anticipated by Applicants' Admitted Prior Art (AAPA). Applicants have amended independent claim 1 to positively recite the step of "removing any remaining portion of said second insulating layer" and support for this removal is set out in claim 4 and on page 8, lines 1-3 of the specification as originally filed. It can be seen illustrated in the invention of Figure 2 there is an absence of

insulating layer 10 which is directly adjacent the epitaxial layer 12. The use of a thin second electrically insulating layer and/or the removal of a portion of that layer on the guard ring 8 during growth of the epitaxial layer 12 leads to "a reduction in the detrimental effect of the thermal expansion coefficient mismatch and producing less epitaxial defects at the window edge" as discussed in Applicants' specification in the last line on page 7.

This improved epitaxial layer feature is common to both embodiments of the present invention, i.e., the embodiment shown in Figures 3-6 and the embodiment shown in Figures 7-10. In both, the epitaxial layer is grown after the thin electrically insulating layer 22 has been created and the second window in the second insulating layer has also been created. Of course, in Figures 5 and 9 in both embodiments, the layer 22 has been removed and subsequently the epi-poly layer 14 is deposited. The removal is now positively recited in independent claims 1 and 26.

Because Applicants' admitted prior art in Figure 1 does not disclose the existence of the relatively thin layer or its removal, there is no disclosure of the reduction in the detrimental effects of thermal expansion coefficient mismatch which is the benefit of the claimed invention.

Thus, at best, the only basis for subsequent rejection of remaining claims 1-11 and newly written claims 25-36 would be under 35 USC §103 as opposed to §102 because the AAPA fails to disclose removing the insulating layer. However, while the AAPA and the present invention have different inventive entities, in both the inventive entities were under an obligation to assign, and indeed did assign, their respective applications, to the same assignee, i.e., QinetiQ Limited. Accordingly, pursuant to the provisions of 35 USC §103(c), subject matter developed by another inventive entity which qualifies as prior art only under one or more of subsection (e) of §102

"shall not preclude patentability under this section where the subject matter and the claimed invention were at the time the invention was made owned by the same person or subject to an obligation of assignment to the same person." Thus, 35 USC §103 is not available as a basis to reject assignee's application in view of the assignee's own prior art under §103(c). Accordingly, any future rejection of remaining claims 1-11 and 25-36 under the provisions of 35 USC §103 is respectfully traversed.

As noted above, Applicants' invention comprises two slightly different methods -- one is disclosed and claimed in generic claim 1 having claims 2-11 and 25 dependent thereon and the other embodiment is set out in independent claim 26, with claims 27-36 dependent thereon. It is noted that claim 1 covers both the first embodiment discussed with respect to Figures 7-10 and the second embodiment discussed with respect to Figures 3-6. Whereas claim 5 specifies that a "further electrically insulating layer" is provided and a "further window" is formed, thereby limiting the generic claim 1 to the embodiment of Figures 3-6, Applicants have added newly written independent claim 26 directed to this specific combination. Therefore, whereas claim 1 is generic, newly written independent claim 26 is specific to the embodiment disclosed in Figures 3-6. Dependent claims 27-36 generally correspond to dependent claims 2-11, with the exception that there is no need to have a duplicate claim 5, since the subject matter of claim 5 is already included in newly written independent claim 26.

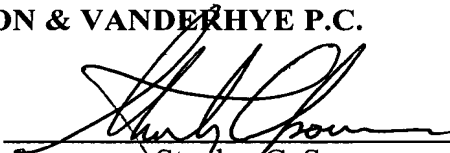
Applicants also noted that original claim 7 might be objected to under U.S. practice as specifying both a range of thickness from 10 nm to 50 nm and also reciting a preferred thickness of 25 nm. Applicants have amended claim 7 to recite only the range and have added newly written claim 25 limiting the range to "about 25 nm."

Having responded to all objections and rejections set forth in the outstanding Official Action, it is submitted that remaining claims 1-11 and 25-36 are in condition for allowance and notice to that effect is respectfully solicited. In the event the Examiner is of the opinion that a brief telephone or personal interview will facilitate allowance of one or more of the above claims, he is respectfully requested to contact Applicants' undersigned representative.

Respectfully submitted,

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